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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/294,956  | 04/20/1999  | INGEMAR J. COX       | 12558               | 6648             |
| 23389   | 7590        | 06/08/2004           | EXAMINER            |                  |
| SCULLY SCOTT MURPHY & PRESSER, PC<br>400 GARDEN CITY PLAZA<br>GARDEN CITY, NY 11530 |             |                      | ZAND, KAMBIZ        |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2132                |                  |
| DATE MAILED: 06/08/2004   |             |                      |                     |                  |

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Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 09/294,956             | COX ET AL.01        |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Kambiz Zand            | 2132                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05 May 2004.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) See Continuation Sheet is/are pending in the application.

4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 130-133 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 15 May 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

Continuation of Disposition of Claims: Claims pending in the application are 1-3,5-16,18-22,24,27-41,47-49,51-62,64,66-68,70,73-87,108-120,122-127 and 129-134.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 1-3,5-16,18-22,24,27-41,47-49,51-62,64,66-68,70,73-87,108-120,122-127,129 and 134..

## DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.
2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
3. **Applicant provisionally elects, the invention of Group III, claims 130-133 in response to Restriction of the claims by the examiner (paper number 23).**
4. Claims 1-3, 5-16, 18-22, 24, 27-41, 47-49, 51-62, 64, 66-68, 70, 73-87, 108-120, 122-127, 129 and 134 are withdrawn from examination.
5. The previous examiner's 101 rejection of claims 130 and 131 have been withdrawn by Examiner, due to applicant's persuasive arguments.
6. Claims 130-133 are pending.

### ***Response to Arguments***

7. Applicant's arguments filed 05/05/04 have been fully considered.

As per applicant's arguments with respect to election of the subject matter of invention III, currently presented by claims 130-133, and Applicant's reference to "the right under 35 U.S.C. § 121 to file one or more divisional application directed to the non-elected claims of the application" (page 2 and 3 of the response), Examiner refers Applicants to the following remarks:

- Examiner request clarification with respect to whether Applicant has elected invention III without traverse or with traverse. Clarification is required.
- Examiner request clarification with respect to status of the non-elected claims. Are the non-elected claims cancelled or withdrawn from the application.  
Examiner request an official amendments in response to this office action in order to clarify the status of the non-elected claims of the application.
- Claim 64 depends on claim 47, which belongs to the claims of the invention I, and therefore has been considered as belong to non-elected claims of the application.

8. Applicant's arguments with respect to elected claims 130-133 (paper number 22, page 26, last paragraph and page 27, first paragraph) filed 02/17/04 have been fully considered but they are moot in view of new ground(s) of rejection.

### **Drawings**

9. New formal drawings are required in this application because original drawings by the applicant were objected to by the Examiner. Fig.1a-e and 4 corresponds to number signs that do not have the corresponding definition of the element numbers shown in the figures such as element number 112 in fig.1a that corresponds to "image pixels" as an example. Some element within Fig.2a-b, 3

and 5 are hard to read and follow. Examiner suggests figure elements to be typed rather than handwriting. Appropriate corrections is requested.

***Claim Rejections - 35 USC § 112***

**10. Claims 130-132** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 130 and 131, the “inserting..” phrases makes the claims indefinite and unclear in that neither method steps nor interrelationship of method steps are set forth in these claims in order to achieve the desired results expressed in the “inserting...” phrases.

**11. Claim 132** recites the limitation "the digital image" in line 4 of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

**12. Claims 130-133** are rejected under 35 U.S.C. 102(e) as being anticipated by Mauratani et al (6,061,451 A).

**As per claim 130** Mauratani et al (6,061,451 A) teach a method for inserting data into digital data for subsequent authentication of the digital data (see fig.1 where the authentication of inserted data digital data that has been received from a network in the form of scrambled data is being authenticated; col.6, lines 12-19 where the data is scrambled by scrambled circuit using an scrambled key, the key corresponds to the inserted data as also shown in col.5, lines 14-16), the method comprising the steps of:

Receiving data from a radio frequency transmission (see col.5, lines 20-24 where the data network received may be received from an antenna that corresponds to a radio frequency that also have antenna transmission and receiver as an inherent part of its system);

Inserting the data into the digital data (see col.5, lines 14-30; col.6, lines 13-20; col.7, lines 65-67; col.8, lines 1-27); and

Authenticating the digital data (see fig.2).

**As per claim 131** Mauratani et al (6,061,451 A) teach a method for inserting data into digital data for subsequent authentication of the digital data (see fig.1 where the authentication of inserted data digital data that has been received from a network in the form of scrambled data is being authenticated; col.6, lines 12-19 where the data is scrambled by scrambled circuit using an scrambled key, the key corresponds to the inserted data as also shown in col.5, lines 14-16), the method comprising the steps of:

Receiving data from an Internet link (see col.8, lines 49-57) ;

Inserting the data into the digital data (see col.5, lines 14-30; col.6, lines 13-20; col.7, lines 65-67; col.8, lines 1-27); and

Authenticating the digital data (see fig.2).

**As per claim 132** Mauratani et al (6,061,451 A) teach a device for inserting data into digital data for subsequent authentication of the digital data (see fig.1 where the authentication of inserted data digital data that has been received from a network in the form of scrambled data is being authenticated; col.6, lines 12-19 where the data is scrambled by scrambled circuit using an scrambled key, the key corresponds to the inserted data as also shown in col.5, lines 14-16) , the device comprising:

An antenna for receiving data from a radio frequency transmission (see col.5, lines 20-24 where the data network received may be received from an antenna that corresponds to a radio frequency that also have antenna transmission and receiver as an inherent part of its system);

Means for inserting the data into the digital data image (see col.5, lines 14-30; col.6, lines 13-20; col.7, lines 65-67; col.8, lines 1-27; also see image data such as mpeg in the entire reference); and

Means for authenticating the digital data (see fig.1).

**As per claim 133** Mauratani et al (6,061,451 A) teach a device for inserting data into a digital image for subsequent authentication of the digital image (see fig.1 where

the authentication of inserted data digital data that has been received from a network in the form of scrambled data is being authenticated; col.6, lines 12-19 where the data is scrambled by scrambled circuit using an scrambled key, the key corresponds to the inserted data as also shown in col.5, lines 14-16), the device comprising:

A computer capable of accessing the Internet and receiving data from an Internet link (see col.8, lines 49-57; col.8, lines 58-63);

Means for inserting the data into the digital image(see col.5, lines 14-30; col.6, lines 13-20; col.7, lines 65-67; col.8, lines 1-27; also see image data such as mpeg in the entire reference); and

Means for authenticating the digital image (see fig.1).

Also see col.5-28 where different embodiment using above methods and means of claims 130-133 are disclosed.

### **Conclusion**

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S.Patent No. US (6,587,837 B1) teach method for delivering electronic content from an online store.

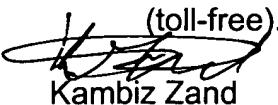
Art Unit: 2132

U.S. Patent No. US (6,396,937 B2) teach system, method, and product for information embedding using an ensemble of non-intersecting embedding generators.

U.S. Patent No. US (6,389,538 B1) teach system for tracking end-user electronic content usage.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (703) 306-4169. The examiner can normally be reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned as (703) 872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197

(toll-free).

  
Kambiz Zand

06/01/04